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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/484,886	01/18/2000	Gale E. Smith	674506-2035.2	1236
20999 7590 08/26/2010 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				
EXAMINER SRIVASTAVA, KAILASH C				
ART UNIT		PAPER NUMBER		
1657				
MAIL DATE		DELIVERY MODE		
08/26/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 09/484,886	Applicant(s) SMITH ET AL.
Examiner Kailash C. Srivastava	Art Unit 1657

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 August 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: Please see Continuation sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: NONE.
Claim(s) objected to: _____.
Claim(s) rejected: 132-152.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: Please see Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: (i) Annotated Newly filed Claim set, (II) Annotated Substitute Specification.

/JON P WEBER/
Supervisory Patent Examiner, Art Unit 1657

Note for 3 and 11 as follows:

Response and amendment filed 09 August 2010 to the Office Action with Final rejection mailed 12 March 2010 is acknowledged.

Applicants argue that the support for Claims new claims 153-169 is in the substitute specification filed 09 August 2010. Applicants have, however, not provided support for said substitute specification because the priority documents from which the support for said substitute specification is shown were not correctly filed. The claims might have been enterable if the specification was enterable. As discussed below, the specification cannot be entered. Additionally, the newly submitted claims are drawn to a different invention, a method, whereas the original claims were drawn to a composition. The Office does not normally entertain switching inventions after an Office action on the merits has been mailed and especially not this late in prosecution: MPEP 8.19

According to 37 C.F.R. §1.78, the claim for benefit must be filed within the four months from the initial filing date of the Application (See, M.P.E.P. §601.1(p)). Accordingly, the benefit for priority under "continuation in part (i.e., CIP)" has not been granted because said Claim for benefit was filed 4 months after the filing date of the instant U.S. Non-Provisional Application Number: 09/484,886. Furthermore, according to the provisions of 37 C.F.R. §1.78 and M.P.E.P. § 601.1(p) the benefit of priority is granted only to U.S. Provisional Application Serial Number 60/118,816 filed 5 February 1999 and to U.S. Provisional Application Serial Number 60/162,254 filed 29 October 1999. The incorporation by reference benefit has not been granted to following references (See Applicants' Substitute Specification filed 09 August 2010, Page 1, 2nd full paragraph).

"U.S. applications Serial Nos. 08/965,698, filed November 7, 1997, 09/169,178, filed October 8, 1998, 09/372,734, filed August 11, 1999, 09/235,901, filed January 22, 1999, 09/169,027, filed October 9, 1998, 08/120,601, filed September 13, 1993 (allowed), now U.S. Patent No. 5,762,939, 08/453,848, filed May 30, 1995 (allowed), now U.S. Patent No. 5,858,368, 09/111,169, filed July 7, 1998, and 08/430,971, filed April 28, 1995 (allowed; U.S. Patent No. 5,976,552 issuing on November 2, 1999)."

In absence of clear support of incorporation by reference, it is difficult to determine whether the substitute specification filed 09 August 2010 as amended is appropriate. Accordingly, the Examiner cannot answer and verify the lengthy substitute specification filed 09 August 2010 in relation to any "new matter" that might have been incorporated, or "lack of written description" in the length substitute specification filed after close of prosecution on 09 August 2010. Since the substitute specification can not be verified, the support for newly presented Claims 153-169 can also not be verified and any opinion presented regarding patentability of said Claims or discussion on the rejections made in the Office Action with Final Rejection mailed 12 March 2010 will be pre-mature.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner can normally be reached on Monday to Thursday from 7:00 A.M. to 5:30 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached at (571)-272-0925 Monday through Thursday 7:30 A.M. to 6:00 P.M. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent Application Information Retrieval (i.e., PAIR) system. Status information for the published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (i.e., EBC) at: (866)-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kailash C. Srivastava
Patent Examiner
Art Unit 1657
(571) 272-0923